

Amendment and Response

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Applicant(s): VOROBA et al.

Group Art Unit: 2684

Serial No.: 09/542,708

Filed: 04 April 2000

For: LOW POWER INFRARED PORTABLE COMMUNICATION SYSTEM WITH WIRELESS RECEIVER AND METHODS REGARDING SAME

Remarks

The Office Action mailed 25 September 2003 has been received and reviewed. Claims 1, 3, and 33 have been amended. Claims 2, 4-5, 17-27, and 36-42 have been canceled. Therefore, claims 1, 3, 6-16, and 28-35 are currently pending in the present application. Reconsideration and withdrawal of the rejections are respectfully requested in view of the above amendments and the following remarks.

Attorney Docket Number

Please note that the Attorney Docket Number has changed from 129.00100101 to **316.0010 0101**. Please refer to the new Attorney Docket Number (316.00100101) in all future correspondence and or communications.

Claim Amendments

Claim 1 has been amended to remove unnecessary limitations. As such, this claim has not been narrowed.

Claim 3 has been amended to correct for proper dependency.

Claim 33 has been amended to correct a grammatical error.

Claims 2, 4-5, 17-27, and 36-42 are canceled without prejudice. Such claims have not been cancelled in view of the art cited by the Examiner and Applicant traverses any rejection of such claims based thereon. Applicant reserves the right to reintroduce one or more of such claims in this or a later continuation application if so desired.

It is also noted that because of a duplicate number 37 in the original application, the set of claims 37-41 was renumbered to claims 38-42. However, such claims have been canceled.

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The 35 U.S.C. §102(b) Rejection

The Examiner rejected claims 28-42 under 35 U.S.C. §102(b) as being anticipated by Strohallen et al., U.S. Patent No. 5,568,516 ("Strohallen et al."). The Examiner alleges that all the limitations of such claims are either described or inherent in Strohallen et al. Applicants respectfully traverse such rejections.

Claims 36-42

Although Applicants respectfully traverse the rejection of claims 36-42 based on Strohallen et al., for reasons other than the art cited against such claims, these claims have been cancelled. As such, the rejection of claims 36-42 based on Strohallen et al. is moot.

Claims 28-35

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference. *See* M.P.E.P. § 2131. Strohallen et al. does not describe each and every element in the claims 28-35.

Claim 28 describes a portable infrared receiver apparatus that includes a receiver housing enclosing a speaker and demodulation circuitry and upon which the infrared light detection device is mounted. The receiver housing is formed to be self-supported entirely by the ear of a user.

Strohallen et al. does not describe a portable infrared receiver apparatus that includes a receiver housing enclosing a speaker and demodulation circuitry and upon which the infrared light detection device is mounted; where the receiver housing is formed to be self-supported entirely by the ear of a user. The Examiner alleges that such a receiver is described with respect to the cordless headset 400, for example, shown in Figure 27. However, as clearly set forth in the specification of Strohallen et al. in column 28, the cordless headset 400 includes a TVM magnetic receiver 404 and a TVM transmitter 410 that may incorporate an RF, infrared, or other suitable transmitter. In other words, the cordless headset 400 includes TVM magnetic receiver and not an infrared receiver as described in claim 28.

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For at least this reason alone, claim 28 is not anticipated by Strohallen et al. and Applicant respectfully requests that this rejection be withdrawn.

Further, as claims 29-35 depend on claim 28, either directly or indirectly, they include the limitations thereof. As such, these claims are also not anticipated by Strohallen et al. for the same reasons as provided above and by reason of their own limitations.

For example, with respect to claim 29, there is nothing in Strohallen et al. that shows an elongated portion of a receiver housing upon which an infrared light detection device is positioned. Strohallen et al. shows an ear supported device in Figure 21, but it does not include the elements of claim 29.

Further, for example, with respect to claims 30-31, there is nothing in Strohallen et al. that describes the structure according to the present invention that allows the receiver of claims 30-31 to be switched from one ear to the other (e.g., speaker holding element that includes an opening defined therethrough sized and configured to receive a speaker from either end of the opening).

Yet further, for example, claim 33 includes limitations substantially similar to those of claims 11 and 23 which have been merely objected to and which are indicated as being in allowable form if rewritten in independent form. As such, Applicant submits that claim 33 is also in allowable form for the same reasons.

In view of the above, Applicant respectfully requests that the rejection of claims 28-35 be withdrawn.

The 35 U.S.C. §103(a) Rejection

The Examiner rejected claims 1-8, 12, 14-21, and 25-27 under 35 U.S.C. §103(a) as being unpatentable over Sulavuori et al., U.S. Patent No. 5,636,264 ("Sulavuori et al.") in view of May, U.S. Patent No. 5,446,783 ("May"). The Examiner further rejected claims 9-10, 13, 22, and 24 under 35 U.S.C. 103(a) as being unpatentable over Sulavuori et al. in view of May and

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further in view of Strohallen et al. The Examiner alleges that all the limitations of such claims are described in the cited references. Applicants respectfully traverse such rejections.

Claims 2, 4-5, 17-22 and 24-27

Applicants respectfully traverse the rejection of claims 2, 4-5, 17-22 and 24-27 based on the cited references. However, for reasons other than the art cited against such claims, these claims have been cancelled. As such, the rejection of claims 2, 4-5, 17-22 and 24-27 based on the cited references is moot.

Claims 1, 3, 6-10 and 12-16

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

The references cited do not teach or suggest all the claim limitations of claims 1, 3, 6-10 and 12-16.

Claim 1 describes a portable communication system that includes an infrared receiver apparatus. The infrared receiver apparatus described in claim 1 includes a receiver housing enclosing a speaker and demodulation circuitry and upon which the infrared light detection device is mounted. The receiver housing is formed to be self-supported entirely by the ear of a user.

Sulavuori et al. does not describe a infrared receiver apparatus that includes a receiver housing enclosing a speaker and demodulation circuitry and upon which an infrared light detection device is mounted; where the receiver housing is formed to be self-supported entirely by the ear of a user. The Examiner alleges that such a receiver is described with reference to Figure 4B and column 6, line 60-column 8, line 30. However, Sulavuori et al. does not describe

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a receiver housing that is self-supported entirely by the ear of a user. The only receiver described in Sulavuori et al. is part of a handset. In other words, the handset 4 that includes the infrared light detection device 206 does not include a receiver housing that is self-supported entirely by the ear of a user.

Neither May nor Strohallen et al. provides any teaching or suggestion that remedies the deficiencies of Sulavuori et al. Therefore, for at least this reason alone, claim 1 is not obvious in view of the cited references. Applicants respectfully request that this rejection be withdrawn.

Further, as claims 3, 6-10, 12-16 depend on claim 1, either directly or indirectly, they include the limitations thereof. As such, these claims are also not obvious in view of the cited references for the same reasons as provided above and by reason of their own limitations.

For example, with respect to claims 6-7, there is nothing in the cited references that teach or suggest an in the ear or behind the ear receiver that includes an infrared receiver.

Further, for example, with respect to claim 8, there is nothing in the cited references that teach or suggest the structure according to the present invention that allows the receiver of claim 8 to be switched from one ear to the other (e.g., speaker holding element that includes an opening defined therethrough sized and configured to receive a speaker from either end of the opening).

Yet further, for example, with respect to claim 12-14, there is nothing in the cited references which describe such circuitry.

In view of the above, Applicant respectfully requests that the rejection of claims 1-10, 12-22, and 24-27 be withdrawn.

Allowable Subject Matter

Applicants further acknowledge that claim 11 has been objected to as being dependent upon a non-elected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However,

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Applicants at this time have not rewritten this claim in independent form as it is believed that this claim is dependent from claims that are in allowable form.

Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
VOROBA et al.

By
Mueeting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228
Customer Number 26813

24 March 2004

Date

By: *Mark J. Gebhardt*

Mark J. Gebhardt
Reg. No. 35,518
Direct Dial (612)305-1216

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of March, 2004, at 12:25 pm (Central Time).

By: *Kelly J. McNulty*
Printed Name: Kelly J. McNulty